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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,466	06/27/2003	Laszlo Vertesy	DEA V2002/0046US NP	9365

5487 7590 06/28/2005

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EXAMINER

OH, TAYLOR V

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	<b>Application No.</b> 10/608,466	<b>Applicant(s)</b> VERTESY ET AL.	
	<b>Examiner</b> Taylor Victor Oh	<b>Art Unit</b> 1625	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 23 May 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.  
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f)..

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
 (b) ☐ They raise the issue of new matter (see NOTE below);  
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

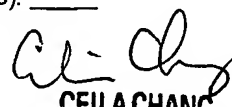
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
 5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
 6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
 The status of the claim(s) is (or will be) as follows:  
 Claim(s) allowed: 1-15 and 20-23.  
 Claim(s) objected to: \_\_\_\_\_.  
 Claim(s) rejected: 16, 18 and 19.  
 Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see pages 2-4.  
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
 13. ☐ Other: \_\_\_\_\_.

  
**CEILA CHANG**  
**PRIMARY EXAMINER**  
**GROUP 1200-160**

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It is noted that applicants have filed an Amendment after the Final Rejection on 5/23/05; applicants' attorney has addressed the issues of record. The proposed amendment will be entered ; however, it is not in a condition for allowance.

**The Status of Claims**

Claims 1-16 and 18-23 are pending.

Claims 16, and 18-19 have been rejected.

Claims 1-15 and 20-23 are allowable.

**Claim Rejections-35 USC 112**

1. Applicants' argument filed 5/23/05 have been fully considered but they are not persuasive.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The rejection of Claims 16 and 18 has been maintained due to applicants' failure to modify the claims in the amendment; however, the rejection of Claims 20-21 has been withdrawn due to the modification made in the claims.

**Claim Rejections-35 USC 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

The rejection of Claim 23 under 35 U.S.C. 102(a) as being anticipated clearly by Deutsche Sammlung (3/18/2002) has been withdrawn due to the convincing Dr. Vera Weihs' letter regarding the terms of the Budapest Treaty.

### **Applicants' Argument**

2. Applicants argue the following issues:

- a. The phrase “ one of its variants and/or mutants ” has been supported with respect to how to obtain such mutants and variants as shown at pages of 12 and 13 of the specification; other issued US patents that contain these terms contain no more support disclosure than that of the present application; therefore, the rejection should be withdrawn.
- b. With respect to the 102(a) rejection based on Deutsche Sammlung (3/18/02), it is merely applicants' own deposit of the microorganism in accordance with the terms of the Budapest Treaty and there is no evidence of prior knowledge by a third party because a copy of letter dated 4/7/2005 from Dr Vera Weihs has described that the deposit was kept secret and out of the public domain until publication of the priority document from which priority is claimed in the present application.

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The applicants' argument have been noted, but these arguments are not persuasive.

First, with respect to the first argument, the Examiner has noted applicants' argument. However, the specification does not explain specifically what its variants and/or mutants can be with respect to the DSM 14865 species; this is vague and indefinite because the specification lines 11-13 on page 12 has given only conclusive description of the product of variants and/or mutants, but no description or enablement how the micro-organism is transformed. Furthermore, with respect to applicants' own deposit of one of its variants and/or mutants of the microorganism, there is absolutely no evidence that applicants have deposited one of its variants and/or mutants of the DSM 14865 species in accordance with the terms of the Budapest Treaty. Also, different US patents have different agendas and issues prior to getting their patents unrelated to the current invention. Therefore, applicants' argument is irrelevant.

Second, with respect to the second argument, the Examiner has agreed with applicants' argument.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

\*\*\*my v gh  
6/22/15

CL-CH

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